Office-Supreme Court, U.S.
FILED
OCT 9 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 154

SERVO CORPORATION OF AMERICA,
Petitioner,

vs.

GENERAL ELECTRIC COMPANY,
Respondent.

PETITIONER'S SUPPLEMENTAL BRIEF

THOMAS F. REDDY, JR.
Attorney for petitioner
330 Madison Avenue
New York, N. Y. 10017

Of Counsel:

PENNIE, EDMONDS, MORTON, TAYLOR & ADAMS,
New York, N. Y.

B. PURNELL EGGLESTON,
Roanoke, Virginia.

KEITH E. MULLENGER,
ROY C. HOPGOOD,
New York, N. Y.

WILSON - EPES PRINTING CO. - RE 7-6002 - WASHINGTON 1, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 154

SERVO CORPORATION OF AMERICA,
Petitioner,

vs.

GENERAL ELECTRIC COMPANY,
Respondent.

PETITIONER'S SUPPLEMENTAL BRIEF

We are filing this Supplemental Brief to call to the Court's attention a very recent development which reflects the concern of the Department of Commerce lest Supreme Court rulings on the patent cases now accepted for review shall be incorrectly interpreted, in regard to the applicable standard of patentability.

In a letter dated October 8, 1965, the General Counsel for the Department of Commerce has expressed to the Office of the Solicitor General a Government interest in and concern with the subject matter of the above-identified petition for certiorari. The Department letter observes that:

"The standard of invention question now before the Court concerns whether enactment of Section 103 superseded the Supreme Court's decision in the *A&P* v. *Supermarket* case in 1950. The question *Servo* presents is whether

the novel arrangement or disposition of even an old element in the combination of old elements removes the matter from the strict interpretation of the *A&P* case. It is possible that this fact situation would be useful to the Court in permitting it to issue positive guidelines since the invention at stake in *Servo* was one which was particularly meritorious. The Servo invention was an infra red hot-box detector used on railroads to prevent accidents resulting from undetected hot-boxes. In short, the *Servo* case could serve as a vehicle for drawing lines between patentable and unpatentable combinations of old elements."

A copy of said letter is attached to and made a part of this Supplemental Brief.

CONCLUSION

For the reasons stated in the Petition, and in our Reply Brief and this Supplemental Brief, the Petition for a Writ of Certiorari should be granted.

October 9, 1965

Respectfully submitted,

THOMAS F. REDDY, JR.
Attorney for petitioner
330 Madison Avenue
New York, N. Y. 10017

Of Counsel:

PENNIE, EDMONDS, MORTON, TAYLOR & ADAMS,
New York, N. Y.

B. PURNELL EGGLESTON,
Roanoke, Virginia.

KEITH E. MULLENGER,
ROY C. HOPGOOD,
New York, N. Y.

CERTIFICATE OF SERVICE

Copies of this Supplemental brief of Petitioner have been served on Respondents by mailing copies to Leonard G. Muse, Woods, Rogers, Muse & Walker, 105 Franklin Road, S.W., Roanoke, Virginia 24004, and to Charles H. Walker, Fish, Richardson & Neave, 277 Park Ave., New York, N. Y. 10017, this 9th day of October, 1965.

THOMAS F. REDDY, JR.
Attorney for Petitioner

APPENDIX TO SUPPLEMENTAL BRIEF

GENERAL COUNSEL OF THE DEPARTMENT OF COMMERCE

Washington, D.C. 20230

October 8, 1965

Honorable Thurgood Marshall
Solicitor General
Department of Justice
Washington, D. C.

Dear Mr. Solicitor General:

This Department has been asked to express an interest in the Government's filing a brief *amicus curiae* in a case now pending on petition for a writ of certiorari before the Supreme Court, *Servo Corporation of America* v. *General Electric Company*.

As a matter of policy, we do not generally recommend Government intervention in patent cases between private litigants unless there is a very significant question of public interest. In the *Servo* case, an issue has been raised which is currently before the Supreme Court in other cases (*Graham* v. *Deere, Colman* v. *Cook, United States* v. *Adams*) which the Court has agreed to review. These essentially raise the question of the standard of patentability under Section 103 of Title 35 of the U.S. Code. It appears that the legal issues are generally the same but the fact situations involved in the other cases before the Supreme Court differ from that of the *Servo* case.

Since the Supreme Court has already taken review in other cases on this question, we believe it is important that you consider the desirability of requesting the Court to take review of the *Servo* case to prevent any denial of justice that might result from finality of the decision

below in the event that the Court's decision on the issues presently before it favors Servo's position. Also, there is an additional factor in the *Servo* case which should be brought to your attention and considered in light of the other issues before the Court.

The standard of invention question now before the Court concerns whether enactment of Section 103 superseded the Supreme Court's decision in the *A&P* v. *Supermarket* case in 1950. The question *Servo* presents is whether the novel arrangement or disposition of even an old element in the combination of old elements removes the matter from the strict interpretation of the *A&P* case. It is possible that this fact situation would be useful to the Court in permitting it to issue positive guidelines since the invention at stake in *Servo* was one which was particularly meritorious. The Servo invention was an infra red hot-box detector used on railroads to prevent accidents resulting from undetected hot-boxes. In short, the *Servo* case could serve as a vehicle for drawing lines between patentable and unpatentable combinations of old elements.

We do not suggest that you intervene in this case on one side or the other but suggest consideration be given to requesting only that the Supreme Court grant the petition for certiorari in order that the issues of the Servo case may be considered along with the other important issues of the standard of patentability which are before the Court.

Sincerely yours,

/s/ Robert E. Giles
ROBERT E. GILES

CC: Mr. Fleming